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In the Supreme Court of the United States

October Term, 1995

Kelly Foods Corporation and J.R.B. Foods, Inc.,
Petitioners,

v.

Windmill Corporation
d/b/a Martha White Foods,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE SIXTH CIRCUIT COURT OF APPEALS

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QUESTION PRESENTED

1. Whether petitioners were denied appellate review as a result of the Sixth Circuit's improper refusal to reach the merits of any of the issues raised in petitioners' appeal?

THE PARTIES

The caption of the case in this Court contains the names of the parties to the proceedings in the Court of Appeals for the Sixth Circuit.

RULE 29.1 STATEMENT

Kelly Foods Corporation has no parent or subsidiaries from which business is transacted.

J.R.B. Foods, Inc. has no parent or subsidiaries from which business is transacted.

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In the Supreme Court of the United States
October Term, 1995

KELLY FOODS CORPORATION and J.R.B. FOODS, INC.
Petitioners,

vs.

WINDMILL CORPORATION
d/b/a MARTHA WHITE FOODS
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit Court of Appeals

OPINIONS BELOW

The opinion of the Court of Appeals for the Sixth Circuit is unreported and appears in the Appendix to this petition at Appendix A-3. The order of the court of appeals denying petitioners' Request for Rehearing appears at Appendix A-28. The order of the district court awarding respondent's attorneys' fees pursuant to 15 U.S.C. § 1117 appears at Appendix A-26. The order of the district court denying petitioners' Motion for Reconsideration Pursuant to Fed. R. Civ. P. 60(b) appears at Appendix A-24. The memorandum of the district court in support thereof appears at Appendix A-17.

JURISDICTION

The judgment of the Court of Appeals for the Sixth Circuit sought to be reviewed is dated January 26, 1996. Petitioners' timely Petition for Rehearing was denied by order of the Court of Appeals for the Sixth Circuit dated March 26, 1996. Jurisdiction of this Court to review the January 26, 1996 judgment is conferred by 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

United States Constitution. Article III, Section 2, Clause 1 provides:

> The Judicial Power shall extend to all Cases, in Law and Equity, arising under this Constitution, the Laws of the United States, and Treaties made, or which shall be made, under their Authority; -- to all Cases affecting Ambassadors, other public Ministers and Consuls; -- to all cases of admiralty and maritime Jurisdiction; -- to Controversies to which the United States shall be a Party; -- to Controversies between two or more States; -- between Citizens of different States; -- between Citizens of the same State claiming Lands under Grants of different States, and between a State, or the Citizens thereof, and foreign States, Citizens or Subjects.

28 U.S.C. § 1291 provides:

> The courts of appeals (other than the United States Court of Appeals for the Federal Circuit) shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the United States District Court for the district of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court. The jurisdiction of the United States Court of Appeals for the Federal Circuit shall be limited to the jurisdiction described in §§ 1292(c) and (d) and 1295 of this Title [28 U.S.C.S. §§ 1292(c), (d), 1295].

28 U.S.C. § 1291 (1986).

STATEMENT OF THE CASE

Respondent, Windmill Corporation, d/b/a Martha White Foods filed a Complaint against Petitioners, Kelly Foods Corporation and J.R.B. Foods, Inc. on November 25, 1992 in the District Court for the Middle District of Tennessee. In essence, the Complaint alleged that petitioners violated Section 43(a) of the Lanham Act by virtue of the distribution and sale of their "CATTY SHACK" cat treat product.

On June 15, 1994, respondent filed an Application pursuant to 15 U.S.C. § 1117 for an award of attorneys' fees which was opposed by petitioners on July 7, 1994.

By order dated July 21, 1994, the district court referred respondent's application to a magistrate judge. In a Report and Recommendation entered November 29, 1994, the magistrate judge recommended that the district court award attorneys' fees to respondent in an amount of $64,776.53.

On December 21, 1994, petitioners' Objections to the magistrate judge's Report and Recommendation were filed with the district court. On that very same date, the district court entered an order stating that "[n]o objections to the Magistrate Judge's Report and Recommendations have been filed within the required time", and thereafter adopted the Report and Recommendation of the magistrate judge. A timely Notice of Appeal invoking the Sixth Circuit's jurisdiction pursuant to 28 U.S.C. § 1291 was subsequently filed by petitioners on January 20, 1995.

Petitioners also filed a Motion for Reconsideration of the district court's December 2nd order on January 9, 1995. The Motion for Reconsideration asked that the district court vacate its order adopting the magistrate judge's Report and Recommendation and consider petitioners' Objections prior to ruling on respondent's application for an award of attorneys' fees.

On February 2, 1995, the district court issued an order denying petitioners' Motion for Reconsideration. A timely Amended Notice of Appeal invoking appellate jurisdiction pursuant to 28 U.S.C. § 1291 was subsequently filed with the Sixth Circuit on February 8, 1995.

The appeal was designated Case No. 95-5137 by the Sixth Circuit.

On June 6, 1995, petitioners filed a Brief of the Appellant in Case No. 95-5137. In the Brief, which was forty-eight (48) pages in length, petitioners raised and addressed in detail two (2) arguments: (1) the magistrate judge applied the wrong legal standard in making an award of attorneys' fees to respondent pursuant to 15 U.S.C. § 1117; and (2) the district court abused its discretion by denying petitioners' Motion for Reconsideration brought pursuant to Fed. R. Civ. P. 60(b)(1).

The Sixth Circuit later consolidated Case No. 95-5137 with another appeal pending between respondent and petitioners -- that is, Case Nos. 94-5874/5890 -- for purpose of submission.

Petitioners subsequently filed their Reply Brief in Case No. 95-5137 on July 19, 1995.

The Sixth Circuit entered an Opinion on January 26, 1996. In its Opinion, the court stated that "[t]he issues before us as raised by Kelly are as follows: whether (1) the "Bonkers" trade dress has acquired a distinctive or secondary meaning?; (2) there is a likelihood of confusion among consumers as to the origin of "Catty Shack" cat treat product?; (3) Kelly was granted an implied license to package its cat treat product in a four-ounce milk carton?; and (4) the language of the permanent injunction issued against Kelly meets the specificity requirement of Federal Rule of Civil Procedure 65(d)?"

All of the above-referenced issues were raised by petitioners pursuant to Case Nos. 94-5874/5890. As to these issues, the Sixth Circuit affirmed the judgment of the district

court finding in favor of both respondent and petitioners as to specific issues.

The opinion does not refer to either issue raised by petitioners in consolidated Case No. 95-5137. Nor does the opinion expound on any legal grounds that would support the affirmance of those issues. In effect, the opinion ignores both of the issues appealed in Case No. 95-5137.

Petitioners filed a Petition for Rehearing with the Sixth Circuit on February 8, 1996, pointing out the court's failure to address Case No. 95-5137 and requesting that the court do so.

On March 26, 1996, the Sixth Circuit denied petitioners' Petition for Rehearing.

REASONS FOR GRANTING THE WRIT

I. Petitioners Were Denied Appellate Review as a Result of the Sixth Circuit's Improper Refusal to Reach the Merits of Any of the Issues Raised in Petitioners' Appeal.

A. The Sixth Circuit's Refusal to Hear Petitioners' Appeal Calls for an Exercise of This Court's Supervisory Authority.

Rule 10.1(a) of the Supreme Court Rules provides in pertinent part:

> A review on writ of certiorari is not a matter of right, but of judicial discretion. A petition for a

writ of certiorari will be granted only when there are special and important reasons therefor. The following, while neither controlling nor fully measuring the Court's discretion, indicate the character of reasons that will be considered:

> (a) When a United States court of appeals . . . has so far departed from the accepted and usual course of judicial proceedings . . . as to call for an exercise of this Court's power of supervision.

This case presents a scenario for review by this Court where a circuit court, after deciding the issues raised in the original appeal, simply neglected to render a decision as to those issues raised in a later consolidated appeal. Rather than remedy the situation when the mistake was brought to its attention, the Sixth Circuit simply chose to ignore its error at the expense of Petitioners.

By its refusal to determine the disposition of the issues raised in Case No. 95-5137, all of which were unequivocally within its jurisdiction, the Sixth Circuit overstepped the boundaries of accepted procedure and effectively denied petitioners their right to appeal -- a result tantamount to a denial of due process. *See Grannis v. Ordean*, 234 U.S. 385, 394 (1914) (a fundamental requirement of due process is "the opportunity to be heard").

This Court, in line with its supervisory power, should correct this situation and instruct the Sixth Circuit to adjudicate this case. *See Thermtron Products, Inc. v. Hermansdorfer*, 432 U.S. 336 (1976) (certiorari granted under Rule 10 where district court refused to adjudicate case and instead remanded it to state court).

B. Because Petitioners Fully Complied With the Rules of Appellate Procedure, Their Appeal Should Have Been Heard.

28 U.S.C. § 1291 provides, in pertinent part, that "[t]he courts of appeal . . . shall have jurisdiction of appeals from all final decisions of the district courts of the United States." 28 U.S.C. § 1291 (1986). This jurisdiction is available as a *matter of right*. *Coppedge v. United States*, 369 U.S. 438, 441 (1962).

Fed. R. App. P. 3 provides that an appeal as of right is taken "by filing a notice of appeal with the clerk of the district court within the time allowed by Rule 4." The time period allotted by Fed. R. App. P. 4 is thirty (30) days after the date of entry of the judgment or order appealed from. There is no question that Petitioners' filing of both their Notice of Appeal and Amended Notice of Appeal was timely, thereby perfecting their Appeal in Case No. 95-5137. *See United States v. Robinson*, 361 U.S. 220 (1960) (the timely filing of a notice of appeal is a jurisdictional prerequisite for perfecting an appeal).

Nothing in the record shows that the Sixth Circuit was justified in its refusal to hear this appeal. Each of the district court's orders for which review was sought was set out in petitioners' Notice of Appeal and Amended Notice of Appeal. Each issue raised by petitioners on appeal appeared in Petitioners' Civil Appeal Pre-argument Statement. Indeed, each was argued in detail in both the Brief of the Appellant and Reply of the Appellant. For example, the Brief of the Appellant was forty eight (48) pages; the length of the Reply was nine (9) pages. Petitioners also prepared and filed a

separate appendix to the briefs in line with Fed. R. App. P. 30.

Petitioners not only complied with all of the applicable appellate rules, but also went to great expense to prosecute their appeal. Their appeal was perfected; it should have been heard.

C. Because None of the Issues Raised by Petitioners was Moot, Their Appeal Should Have Been Heard.

There is nothing in the record showing that either of the issues raised in petitioners' appeal was moot so as to bar the Sixth Circuit's exercise of jurisdiction. The issues in this case still present an actual case or controversy -- that is, petitioners still contend that attorneys' fees were improperly awarded pursuant to 15 U.S.C. § 1117. Respondent, of course, contends otherwise.

Nor is there any showing in the record that the Sixth Circuit, having decided one dispositive issue, exercised its discretion not to address an equally dispositive issue. *See United States v. Leon*, 468 U.S. 897 (1984) (Fourth Amendment issue may be decided as a matter of discretion before addressing "good faith exception" for warrantless searches).

CONCLUSION

The Sixth Circuit does not have the judicial discretion to pick and choose appeals for review. Barring mootness or a failure to comply with the Rules of Appellate Procedure, a perfected appeal should be heard. The Sixth Circuit's practice in this case does not comport with the established rules of appellate procedure promulgated by this Court. Nor does this practice comport with the language of 28 U.S.C. § 1291.

For the above reasons, it is prayed that the judgment of the Court of Appeals for the Sixth Circuit be vacated and this case remanded to the Sixth Circuit for further proceedings.

Respectfully submitted,

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Appendix

BEST AVAILABLE COPY

OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

(Filed January 26, 1996)

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

Nos. 94-5874/5890
95-5137

WINDMILL CORPORATION,
d/b/a MARTHA WHITE FOODS
Appellee, Cross-Appellants,

v.

KELLY FOODS CORPORATION; J.R.B. FOODS, INC.,
Appellants, Cross-Appellees.

Before: MARTIN and JONES, Circuit Judges; and BELL, District Judge[1]

PER CURIAM. Before this court is defendant/appellant Kelly Foods Corporation's (Kelly) appeal and plaintiff/cross-appellant Windmill Corporation d/b/a Martha White Food's (Windmill) appeal from an order permanently enjoining Kelly from producing, marketing,

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[1]The Honorable Robert Holmes Bell, United States District Judge for the Western District of Michigan, sitting by designation.

selling or distributing "Catty Shack" cat treat products in its current trade dress. The issues before us as raised by Kelly are as follows: whether (1) the "Bonkers" trade dress has acquired a distinctive or secondary meaning?; (2) there is a likelihood of confusion among consumers as to the origin of "Catty Shack" cat treat product?; (3) Kelly was granted an implied license to package its cat treat product in a four-ounce milk carton?; and (4) the language of the permanent injunction issued against Kelly meets the specificity requirement of Federal Rule of Civil Procedure 65(d)? Windmill would have us consider whether the district court erred as a matter of law in finding that the shape of the "Bonkers" package is functional? For the reasons that follow, we affirm the district court.

Windmill or one of its predecessors in interest has distributed "Bonkers" cat treats in four-ounce gable-top (milk carton) containers since 1984. Under a real property purchase agreement dated October 20, 1987, Kelly purchased a Berlin. Maryland, pet food manufacturing facility, including real and personal property from Pet Specialties, Inc., a division of Beatrice Foods, one of Windmill's predecessors. Among the personal property sold was a PURE-PAK packaging machine that was used to package dog and cat foods in four-ounce milk cartons. Pursuant to a one-year agreement also dated October 20, 1987, Kelly packaged the "Bonkers" product for Windmill at Kelly's plant in Berlin, Maryland. The packaging agreement provided that "[n]othing herein shall be deemed to give [Kelly] any claim or right in the labels or in the trademarks of [Windmill]." A non-disclosure agreement executed on January 11, 1989, provided as follows:

> Notwithstanding anything to the contrary set forth above, [Windmill] hereby acknowledges that it has

> previously contracted with [Kelly] for the production of Bonkers. [Windmill] further acknowledges that [Kelly] has an equal interest in the formulas for Bonkers. As a result of the foregoing, [Windmill] agrees that this letter shall not be applicable to the *formulas for Bonkers nor the manufacturing techniques, processes, know how and trade secrets* utilized by [Kelly] in the production thereof, nor shall it be construed to preclude [Kelly] from producing or selling cat treats under the same or a different formula under a name other than Bonkers. (Emphasis added.)

After the agreement expired, Kelly continued to package "Bonkers" on a month-to-month basis until October 1992. Kelly made an informal offer of approximately one million dollars to Windmill for the name "Bonkers." Windmill rejected the offer. Ralston Purina offered in excess of three million dollars. On June 18, 1992, Kelly began to market its "Catty Shack" cat treat product, which is also sold in four-ounce milk cartons, and includes features that are similar to the "Bonkers" milk carton. Besides the color and shape of the carton, these similarities include the color codes, the location and font of the color designations, and the positioning and color of the phrase "cat treat." Robert Kelly, President of Kelly, testified that Lana Kennedy, designer of the "Catty Shack" package, had "Bonkers" containers in her possession in the final stages of the design process. This, Kelly asserted, was to ensure that the "Catty Shack" packages were not "exact" in color to the "Bonkers" packages. On August 14, 1992, Kelly gave notice to Windmill that it was going to cease packaging "Bonkers" as of October 1, 1992.

Prior to the sale of "Catty Shack," "Bonkers" was the

only cat treat sold in the United States with a four-ounce gable-top container.[2] According to Kelly, the function served by the milk carton container does not dictate the shape of the container. Windmill contends that the four-ounce milk carton container facilitates filling the container in the production process, and allows the consumer to reseal the carton. Other forms of packaging are less expensive. Windmill considered, on more than one occasion, changing its packaging to a lower cost option but declined to do so because of an association by consumers of "Bonkers" with the shape of its container.

Bil-Jac Foods, a Kelly affiliate, has been packaging pet foods in milk cartons since the early 1960s. Further, "Taniami" and "Eukanuba" dog food have been packaged in milk cartons since at least the 1970s. Bil-Jac distributes trial sizes of puppy food, cat food, dog food and liver treats in four ounce milk cartons. In addition, the Kit Cat Glow cat food by Wayne®, the IAMS' cat and kitten foods, as well as Purina Kitten Chow® are sold in milk carton containers of varying sizes. One firm sells dog and puppy foods in half-gallon milk carton containers. The district court found that competing brands of cat treats as well as dog treats offered similar color schemes for comparable product lines. Background colors are used to designate flavor of food in the pet food industry.

Windmill conducted a consumer survey among 99 cat owners who purchase cat treats at least once per year. The cat owners were asked whether they had seen cat treats packaged

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[2]Apparently, a Canadian cat treat named "Trixie" has a similar container, but the magistrate judge found, contrary to Kelly's proofs, that it had not been sold in the United States.

in small milk-type cartons. Seventy-six percent responded affirmatively. Among these 75 people, 32 percent cited "Bonkers" as a cat treat packaged in a milk carton container. When the remaining respondents were prompted that "Bonkers," along with four other brands, is a brand of cat treats, 39 percent identified it as a cat treat packaged in a milk-type carton. The survey concludes (by combining the two percentages) that 71 percent of the survey respondents associate "Bonkers" with a milk-type carton. Actually, of the original 99 cat owner-respondents, only 24 were able to link "Bonkers" with the milk-carton package and an additional 20 were able to do so after being prompted with five brands. Therefore, only about 24 percent associated "Bonkers," without prompting, with a milk-type carton. The percentage rises to only 44 percent with prompting. The district court accepted the survey conclusion (71 %) as evidence that the "Bonkers" packaging had a distinctive, secondary meaning in the marketplace.

II.

15 U.S.C. § 1125(a)(1) (the Lanham Act) provides in pertinent part:

> Any person who, on or in connection with any . . . container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin . . . which is likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin . . . of his or her goods . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

This section has been construed to protect the "trade dress"[3] of a product under the same principles that protect registered trademarks. *Two Pesos, Inc., v. Taco Cabana, Inc.*, 505 U.S.____, 120 L. Ed. 2d 615, 623 (1992). Trade dress is classified in categories of generally increasing distinctiveness. A dress may be "(1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Id. (quoting Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)). The latter three categories, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and entitled to protection. The first two categories may become distinctive when either acquires a secondary meaning in the marketplace. *Id.* at 624. Secondary meaning is used generally to indicate that a dress has come through use to be uniquely associated with a specific source. *Id.* at 622 n.4. Nonfunctionality and proof of a likelihood of confusion are, also, a prerequisite for protection. *Id.* at 624. Thus, to sustain a claim for trade dress infringement, a plaintiff must prove that the allegedly misappropriated features of the dress (1) are inherently distinctive or have acquired distinction by virtue of secondary meaning in the marketplace; (2) are not functional; and (3) create a likelihood of confusion as to the source of defendant's goods.

III.

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[3]The 'trade dress' of a product is essentially its total image and overall appearance." "It 'involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques'" *Two Pesos*, 120 L. Ed. 2d at 621 n.1 (citations omitted).

Kelly argues that it was granted an implied license to package its cat treat product in a four-ounce milk carton. Due to the language of the one-year co-packing agreement (executed the same day as the purchase agreement wherein Kelly acquired Windmill's packaging machine) that "[n]othing herein shall be deemed to give [Kelly] any claim or right in the labels or in the trademarks of [Windmill]," the district court found Kelly had not been granted an implied license to sell its cat food in a four-ounce milk carton. Assuming that a four-ounce milk carton is a trademark of Windmill, the language quoted precludes any implication that Kelly was receiving a license to sell its own cat treats in a four-ounce milk carton. Kelly's argument that it defies common sense for a company to purchase such a large expensive piece of equipment for the benefit of a one-year agreement is immaterial. One's business judgment or lack thereof cannot eviscerate the unambiguous language of their co-packing agreement entered into the same day as the purchase agreement.

IV.

Answering the question, whether a four-ounce milk carton is a trademark of Windmill, can be determined at a threshold level if the container is functional.

> [A] design is legally functionable, and thus unprotectable, if it is one of a limited number of equally efficient options available to competitors and free competition would be unduly hindered by according the design trademark protection. This serves to assure that competition will not be stifled by the exhaustion of a limited number of trade dresses.

Two Pesos, 120 L. Ed. 2d at 627-28. Expanding on this standard, "[a] product feature is functional 'if it is essential to the use or purpose of the article or if it effects the cost or quality of the article.'" *Ferrari S. P. A. Esercizio Fabriche Automobili E Corse v. Roberts*, 944 F.2d 1235, 1246 (6th Cir. 1991) (citation omitted). In addition, "a functional feature is one which competitors would have to spend money not to copy but to design around." *Someday Baby, Inc., JTG of Nashville, Inc.*, 744 F.Supp. 811, 813 (M.D. Tenn. 1990).

The magistrate judge concluded that the four-ounce milk carton was legally functionable and could not be protected. This conclusion was supported by the milk carton being one of several types of containers available, and by it serving the function of resealability, which makes the cat treat attractive to consumers who use it over time as well as affecting the quality and cost of the product. In addition, given Kelly's milk carton packaging machine at its Berlin, Maryland, plant, Kelly would have to spend money to design around the milk carton. The district judge noted that the many pet food and non-pet food consumer products today that are packaged in milk cartons lend to the conclusion that milk-type cartons serve functionality. The district judge, also recognized the utilitarian features of milk cartons that are absent from alternatives. Some of these features are described in the presumably expired United States Letters Patent No. 2,750,095, issued on June 12, 1956. (App. at 595). These are ample reasons to find functionality under a clearly erroneous standard of review Fed. R. Civ. P. 52(a).

V.

"To acquire a secondary meaning in the minds of the buying public, an article of merchandise when shown to a

prospective customer must prompt the affirmation, 'That is the article I want because I know its source,' and not the negative inquiry as to 'Who makes that article?' In other words, the article must proclaim its identification with its source, and not simply stimulate inquiry about it." *Roberts*, 944 F.2d at 1239. The magistrate judge concluded that "Bonkers" has acquired a distinctive and secondary meaning for the following reasons: (1) the multi-million dollar offers for the "Bonkers" tradename; (2) "Bonkers" is the market leader in the cat treat industry[4]; (3) the consumer survey results; and (4) Windmill's obvious copying of "Bonkers" overall appearance. Each reason will be addressed.

A. Relevance of the multi-million dollar offers

As the nondisclosure agreement indicates, Kelly already had the rights to the "Bonkers" formula. Its one million dollar offer was, therefore, only for the name "Bonkers." That there were multi-million dollar offers, Ralston Purina being willing to offer $3.5 to 4 million dollars for the rights to "Bonkers Cat Treats," not merely for the name "Bonkers" as the magistrate Judge concluded, does not tell the court what the trade dress was worth to others, if it was worth anything at all. A finding of secondary meaning does not, however, turn on this point.

B. Relevance of being a market leader

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[4]Windmill noted, in its brief, the magistrate judge's error in ranking "Bonkers" first in the cat treat market. "Bonkers," according to a December 1988 Offering Memorandum, is the second leading seller in the cat treat market. (Brief at 27 n.9)

"Bonkers" was second (not first as the magistrate concluded and as plaintiff conscientiously noted) in sales in the cat treat industry. The evidence relied upon by the magistrate was an October 7, 1988, offering memorandum wherein it indicated that "Bonkers" had a 22.3 percent market share during the previous year. This figure (which appears to be rather low for the purposes for which it was offered into evidence) tells the court nothing about its market share at the time of the complaint in November 1992, and certainly nothing about whether its trade dress had a secondary meaning in the marketplace. Nonetheless, this fact is, also, not integral to a finding of secondary meaning.

C. Relevance of consumer survey

The consumer survey does not tell the court as much as the magistrate judge would like to see. Of those small number participating in the survey (99), only about 24 percent associated "Bonkers," without prompting, with a milk-type carton. The percentage rises to only 44 percent with prompting. In *Spraying Systems Co. v. Delaven, Inc.*, 762 F.Supp. 772, 779 n.6 (N.D. Ill. 1991), the court noted that "in order to prove secondary meaning a "substantial" portion of buyers must associate the product with one source, and generally over 50% is regarded as clearly sufficient to that end, while a 38% figure would have been marginal even in a properly designed survey." Neither 24 or 44 percent seem to be that high so as to indicate a distinctive or secondary meaning in the marketplace. Moreover, this survey does not go to the distinctiveness or secondary meaning in the market place of the "Bonkers" non-functional trade dress. It only addresses the survey participants' identification of the name, "Bonkers," with a milk carton container, the latter not being protected because of its functionality. The survey does

not address the other characteristics of its trade dress. Again, however, secondary meaning can still be found.

D. Kelly's copying of "Bonkers'" overall appearance

Under *Roberts*, 944 F.2d at 1242-43, relied upon by the magistrate,

> "[The] intent of [a party] in adopting [another's mark] is a critical factor, since if the mark was adopted with the intent of deriving benefit from the reputation of [the plaintiff,] that fact alone may be sufficient to justify the inference that there is confusing similarity." (Citation omitted.)

The magistrate concluded that Windmill intended to copy "Bonkers'" overall appearance by virtue of its package form and background colors, the display of wording, the titles of the flavors and the use of cat figures similar to the "Bonkers" original design . . . ." In addition, the magistrate pointed to Kelly's obvious knowledge of the volume of "Bonkers'" business, its long history of producing "Bonkers" and the access of Kelly's designer to the "Bonkers" treat, to reach the conclusion that Kelly had intentionally copied the "Bonkers" trade dress. These findings are sustainable under a clearly erroneous standard of review to find intentional copying and, thus, sufficient to uphold a presumption that "Bonkers" has acquired secondary meaning. *See id.* at 1239.

IV.

Under *Kwik-Site Corp. v. Clear View Mfg. Co.*, 758 F.2d 167, 178 (6th Cir. 1985), seven factors can be considered in determining a likelihood of confusion: "(1)

degree of similarity (of the trade dress or product configuration); (2) similarity of goods or services for which the marks are used; (3) area and manner of concurrent use; (4) strength of the mark; (5) sophistication of purchasers; (6) plaintiff's intent; and (7) actual confusion." Actual confusion need not be proven *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1190 (6th Cir. 1991). Using these standards, the magistrate judge concluded that confusion was likely because of the similarity of the package form and background colors, the display of the wording, the titles of the flavors and the use of the cat figures similar to the "Bonkers" original design. The district judge added, "One need only look briefly at the actual Catty Shack and Bonkers packages to see that they are confusingly similar." We agree. A "side-by-side examination or comparison," *Mihalek Corp. v. State of Michigan*, 814 F.2d 290, 297 (6th Cir. 1987), leads us to conclude that the ordinary purchaser would be confused as to the source of origin.

> It is so easy for the honest business man, who wishes to sell his goods upon their merits, to select from the entire material universe, which is before him, symbols, marks and coverings which by no possibility can cause confusion between his goods and those of competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish between them. The law is not made for the protection of experts, but for the public--that vast multitude which includes the ignorant, the unthinking and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearances and general impressions."

Florence Mfg. Co. v. J.C. Dowd & Co., 178 F. 73, 75 (2d Cir. 1910); *accord Hemmeter Cigar Co. v. Congress Cigar Co.*, 118 F.2d 64, 70 (6th Cir. 1941).

VII.

Finally, Kelly argues that the language of the permanent injunction issued against it fails to meet the specificity requirement of Fed. R. Civ. P. 65(d). The district court enjoined Kelly "from producing, marketing, offering for sale, selling, or distributing "Catty Shack" cat treat products in its current trade dress and in any other that is not substantially different from the Bonkers trade dress." The parties are currently involved in contempt proceedings based on Kelly's redesigned packaging. Federal Rule of Civil Procedure 65(d) requires that "[e]very order granting an injunction . . . shall be specific in terms; shall describe in reasonable detail . . . the act or acts sought to be restrained." "But the Rule does not require the impossible. There is a limit to what words can convey. The more specific the order, the more opportunities for evasion ("loopholes")." *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1431 (7th Cir. 1986). Thus, an injunction against "any colorable imitation" satisfied the rule. *Id.* at 1432. In *Wynn*, 943 F.2d at 609, this circuit affirmed an injunction prohibiting the defendants from using a mark "confusingly similar" to the plaintiff's mark. The district court's "not substantially different" language is as clear as *Wynn's* "confusingly similar" language or *Euroquilt's* "any colorable imitation."

Kelly knows what it cannot imitate. The district court indicated in its opinion the areas of infringement by its adoption of the magistrate's report and recommendation

which addressed the same: "In addition to package form and background colors, the display of wording, the titles of the flavors and the use of cat figures similar to the "Bonkers" original design are factors that are likely to lead to confusion." Mag. Rep. & Rec. at 19. The district court cannot be expected to redesign defendant's packaging for it. That the parties are involved in contempt proceedings adds no weight to defendant's argument. The text of the injunction (though surely capable of being more specific), read in the context of the magistrate's report and recommendation, is sufficient to enlighten Kelly concerning what is forbidden, and is not clearly erroneous. "Rule 65(d) does not require a torrent of words when more words would not produce enlightenment about what is forbidden." *Euroquilt* at 1432.

Finding no clear error below, we AFFIRM the judgment of the district court.

MEMORANDUM OF THE UNITED STATES DISTRICT COURT MIDDLE DISTRICT OF TENNESSEE NASHVILLE DIVISION

(Dated February 1, 1995)

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF TENNESSEE
NASHVILLE DIVISION

No. 3-92-1050

WINDMILL CORPORATION[1]
d/b/a MARTHA WHITE FOODS

v.

KELLY FOODS CORPORATION, et al.

MEMORANDUM

The Court has before it the defendants' motion (filed January 9, 1995; Docket Entry No. 98) for reconsideration and their memorandum (filed January 9, 1995; Docket Entry

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[1]On August 30, 1994, the plaintiff, Windmill Corporation, filed its motion (Docket Entry No. 86) To substitute The PFB Partnership, L.P., As the party plaintiff. The Court granted this motion by its order (Docket Entry No. 93) entered December 5, 1994.

No. 99) in support, as well as the plaintiff's response (filed January 17, 1995; Docket Entry No. 102).

For the reasons set forth below, the Court shall deny the defendants' motion.

I.

The underlying facts of this action were set forth in the Court's previous memorandum (entered March 24, 1994; Docket Entry No. 56) accompanying its order (Docket Entry No. 57) granting the plaintiff's motion (filed September 13, 1993; Docket Entry No. 23) for a preliminary injunction[2] and need not be reiterated here. The plaintiff's subsequent application (filed June 15, 1994; Docket Entry No. 71) for attorney's fees was referred to the Magistrate Judge for consideration and disposition by the Court's order (Docket Entry No. 81) entered July 21, 1994. In his Report and Recommendation (entered November 29, 1994; Docket Entry No. 90), the Magistrate Judge recommended that the Court award the plaintiff's counsel attorney's fees and expenses in the amount of $64,776.53. No objections to the Magistrate Judge's Report and Recommendation were filed within the required time.[3] The Court independently reviewed the Report

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[2]On June 1, 1994, this preliminary injunction was converted into a permanent injunction and a final judgment by agreement of the parties. *See* order (Docket Entry No. 70).

[3]It was not until December 21, 1994, after the requisite time parameters, that the defendants' objections to the Report and Recommendation were filed with the Clerk's office.

and Recommendation and the entire record, and on December 21, 1994, adopted and approved the Magistrate Judge's findings and conclusions. *See* order (Docket Entry No. 96).

On that same day, the defendants' objections (Docket Entry No. 97) to the Report and Recommendation were filed with the Clerk's office. The motion (Docket Entry No. 98) now before the Court was then filed by the defendants on January 9, 1995. In their motion, the defendants request that the Court vacate its order, consider the defendants' objections to the Magistrate Judge's Report and Recommendation prior to issuing a ruling thereon, and deny the plaintiff's application for an award of attorney's fees.

The defendants contend that the Court should vacate its order of December 21, 1994 (Docket Entry No. 96) pursuant to Fed. R. Civ. P. 59(e). Defendants memorandum (Docket Entry No. 99) at 4. They assert that the Magistrate Judge substantively erred in awarding attorney's fees pursuant to 15 U.S.C. § 1117, citing the unexceptional nature of this action. Defendants' memorandum at 5-7. More specifically, they contend that the Magistrate Judge's recommendation that the plaintiff be awarded attorney's fees, "despite Plaintiff's admission that it could not prove damages," is erroneous and contrary to precedent established by the United States Court of Appeals for the Sixth Circuit. *Id.* at 5. They further assert that the fees and expenses awarded were both excessive and unjust. *Id.* at 6. Alternatively, the defendants contend that the Court should vacate its order pursuant to Fed. R. Civ. P. 60(b) and consider the defendants' objections to the Report and Recommendation as part of the record prior to making its ruling on the plaintiff's application for an award of attorney's fees. *Id.* at 7.

II. -

The Court finds that the defendants' contentions are without merit. As an initial matter, the Court notes that the defendants' objections to the Report and Recommendation were filed several days after the required time period and, therefore, are not timely. The defendants have explained that the late filing of their objections was due to a clerical error in omitting the Clerk's office room number on the Federal Express air.bill. *Id.* at 1-2. They characterize their neglect in filing their objections as "due to 'unique or extraordinary' circumstances," and assert that the underlying clerical error constitutes excusable neglect. *Id.* at 8.

The Court finds that the circumstances surrounding the defendants' neglect, namely, failing to provide a complete address on the material to be mailed, hardly rise to the level of "unique or extraordinary." The error which resulted in the untimely filing of the defendants' objections does not constitute the type of mistake or excusable neglect which justifies relief from the Court's order. If it did, virtually any simple clerical error would be deemed sufficient to invoke the extraordinary relief provided by Rule 60(b).

Furthermore, the Court is satisfied that the Magistrate Judge's conclusion that this action is one of the "exceptional cases" in which reasonable attorney fees may be awarded to the prevailing party is correct. As noted by the Sixth Circuit, an "exceptional" case under the Lanham Act is one in which the infringement is "malicious, willful, fraudulent, or deliberate." *Wynn Oil Co. v. American Way Serv. Corp.*, 943 F.2d 595, 607 (6th Cir. 1991). Such deliberate infringement is reflected in the Magistrate Judge's conclusions that "defendants copied the 'Bonkers' cat treat products overall

image" and that "defendants intended to replicate the 'Bonkers' product image," Report and Recommendation (Docket Entry No. 42) at 19-20, as well as the facts in the record which led to these conclusions. *Id.* at 7-10. The Magistrate Judge's findings of fact and conclusions of law were expressly approved and adopted by the Court in its order (Docket Entry No. 57) entered March 24, 1994.

The defendants nonetheless contend that this action cannot be exceptional as there was no finding of damages, citing *Hindu Incense v. Meadows*, 692 F.2d 1048 (6th Cir. 1982). The defendants' reliance on the *Hindu* case is misplaced.[4] In *Hindu*, the Sixth Circuit found that the appellee's admission that there had been no loss of sales due to the infringement was an important consideration, and that "[s]uch a finding generally makes the case unexceptional for purposes of awarding fees under § 1117." 692 F.2d at 1052.

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[4]The Court notes that, in addition to the obvious difference that the *Hindu* case involved a trial on the merits, while this action involves a preliminary injunction which was converted into a permanent injunction, the *Hindu* case is distinguishable from this action in numerous other ways. In *Hindu*, the district court found that the appellant's adoption of the appellee's trademark was not fraudulent, and the appellants were apparently under the mistaken belief that the appellee had ceased use of the trademark in question. 692 F.2d at 1052. In contrast, in this action, the Magistrate Judge made a specific finding of the defendants' intentional infringement which was approved and adopted by the Court. Furthermore, there is no evidence indicating that the defendants mistakenly believed that the plaintiff had discontinued use of the contested trade dress.

However, in this action, the plaintiff has made no such admission. Instead, in order to expedite the granting of permanent injunctive relief, the plaintiff agreed to the conversion of the preliminary injunction into a permanent injunction and a final judgment[5] rather than seek a determination of damages. Thus, although there has been no determination of specific damages due to the infringement, the plaintiff has not conceded that no such damages were incurred but simply made the election that any damages it could obtain were secondary to the desired injunctive relief. *See* plaintiff's memorandum (Docket Entry No. 102) at 6. Despite the defendants' contention that this action is not exceptional in light of "Plaintiff's admission that it could not prove damages," defendants' memorandum (Docket Entry No. 99) at 5, the record is barren of any evidence that the plaintiff made any admission of its inability to prove damages resulting from the infringement.

III.

In summary, the Court finds that the defendants' neglect which resulted in their untimely filing of objections to the Report and Recommendation is not excusable and does not justify the extraordinary relief afforded by Fed. R. Civ. P. 60(b). Furthermore, the Court finds that this action is an exceptional case in which reasonable attorneys' fees may be awarded to the prevailing party.

Accordingly, the Court shall deny the defendants' motion (Docket Entry No. 98) for reconsideration.

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[5]*See* order (Docket Entry No. 70).

It shall be ORDERED.

/s/ Thomas A. Higgins
United States District Judge

ORDER OF THE UNITED STATES DISTRICT COURT MIDDLE DISTRICT OF TENNESSEE NASHVILLE DIVISION

(Dated February 1, 1995)

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF TENNESSEE
NASHVILLE DIVISION

No. 3-92-1050

WINDMILL CORPORATION[1]
d/b/a/ MARTHA WHITE FOODS

v.

KELLY FOODS CORPORATION, et al.

ORDER

In accordance with the memorandum contemporaneously entered, the motion (filed January 9, 1995; Docket Entry No. 98) of the defendants, Kelly Foods

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[1]On August 30, 1994, the plaintiff, Windmill Corporation, filed its motion (Docket Entry No. 86) to substitute the PFB Partnership, L.P., as the party plaintiff. The Court granted this motion by its order (Docket Entry No. 93) entered December 5, 1994.

Corporation and JRB Foods, Inc., for reconsideration is denied.

It is so ORDERED.

/s/ Thomas A. Higgins
United States District Judge

ORDER OF THE UNITED STATES DISTRICT COURT MIDDLE DISTRICT OF TENNESSEE NASHVILLE DIVISION

(Dated December 21, 1994)

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF TENNESSEE
NASHVILLE DIVISION

No. 3-92-1050

WINDMILL CORPORATION d/b/a
MARTHA WHITE FOODS

v.

KELLY FOODS CORPORATION, et al.

ORDER

No objections to the Magistrate Judge's Report and Recommendation (entered November 29, 1994; Docket Entry No. 90) have been filed within the required time.

After independently reviewing the Report and Recommendation and the entire record, the Court finds the Magistrate Judge's findings and conclusions are correct and they are adopted and approved.

Accordingly, the plaintiff's application (filed June 15,

1994; Docket Entry No. 71) for award of attorney's fees and expenses is granted as modified by the Magistrate's Report. The plaintiff is awarded fees and expenses in the amount of $64,776.53.

It is so ORDERED.

/s/ Thomas A. Higgins
United States District Judge

ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

(Filed March 26, 1996)

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

No. 95-5137

WINDMILL CORPORATION,
d/b/a MARTHA WHITE FOODS
Plaintiff - Appellee,

v

KELLY FOODS CORPORATION; J.R.B. FOODS, INC
Defendants - Appellants.

Before: MARTIN and JONES, Circuit Judges; and BELL, District Judge*

ORDER

Upon consideration of the petition for rehearing filed by the appellants,

It is ORDERED that the petition for rehearing be, and it hereby is, DENIED.

ENTERED BY ORDER OF THE COURT

/s/ Leonard Green
Clerk

*The Honorable Robert Holmes Bell, United Western District Judge for the Western Michigan, sitting by designation.

ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

(Filed June 22, 1995)

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

Nos. 94-5874/5890
95-5137

WINDMILL CORPORATION,
d/b/a MARTHA WHITE FOODS
Plaintiff - Appellee Cross-Appellant (94-5874/5890)

v.

KELLY FOODS CORPORATION; JRB FOODS, INC.,
Defendants -*Appellants, Cross-Appellees*

WINDMILL CORPORATION,
d/b/a MARTHA WHITE FOODS
Plaintiff - Appellee (95-5137)

v.

KELLY FOODS CORPORATION; JRB FOODS, INC.
Defendants - Appellants

ORDER

Upon consideration of the motion filed by Kelly Foods Corporation and JRB Foods. Inc., to consolidate 95-5137 with cross-appeals 94-5874/5890 for purpose of submission,

It is ORDERED that the motion be and it hereby is GRANTED.

ENTERED PURSUANT TO RULE 8(b), RULES OF THE SIXTH CIRCUIT.

/s/ Leonard Green
Clerk